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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,694	12/22/2003	James P. Kleckner	P01091US2A	7802

7590 09/27/2005

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EXAMINER
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MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,694

Applicant(s)

KLECKNER, JAMES P.

Examiner

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>061704,051204</u> .   | 6) <input type="checkbox"/> Other: ____                                     |

1) This application contains claims directed to the following patentably distinct species of the claimed invention:

species #1 - tire having tag carried by reinforcing belt

as shown in figures 1-3, 3A, 3B

species #2 - tire having tag disposed in cavity of sidewall

as shown in figures 4, 4A and 5.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2) During a telephone conversation with Fred Zollinger on 9-21-05 a provisional election was made without traverse to prosecute the invention of species #2, claims 9-16 and 18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) **Claims 9-13, 15-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 325 (JP 2001-63325).**

Japan 325 discloses a tire having a tread 1, belt 2, carcass 4, bead wires 5, bead part 8, side tread 3, recess 8a and transponder 7 having receiver and transmitter functions wherein transponder ("tag") is disposed in the recess 8a ("cavity"). See translation and figure 1. The distance A between the center of the transponder 7 and

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the rim flange is up to 100 mm (3.93 inches). See page 9 of translation and figure 6. As can be seen from figure 1, recess 8a is shown as having "an opening at the outer surface of the sidewall". It is noted that Japan 325 describes holding the transponder "by the side tread rubber [sidewall rubber]". See page 8 of translation.

Claim 9 is anticipated by Japan 325's tire. The claimed cavity reads on the recess 8a. The claimed tag reads on the transponder. The claimed bead portion reads on the portion including bead wire 5. The description of "at the outer surface of the sidewall" fails to require a location different from that disclosed by Japan 325. It is emphasized that the center of Japan 325's transponder may be 100 mm (3.9 inches) above the rim flange.

As to claims 10-13, Japan 325 teaches coating the transponder with epoxy resin. See for example page 13 of translation. The claimed encapsulation material reads on the epoxy resin.

As to claims 15-16, see location of transponder / recess shown in figure 6 and described on page 9 of the translation.

As to claim 18, see enlargement of the recess and cavity shown in figure 1.

6) **Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 325 in view of Europe 196 (EP 1049196).**

As to claims 10-13, it would have been obvious to one of ordinary skill in the art to encapsulate Japan 325's transponder for a tire with encapsulation material (claim 10) / entirely surround the transponder with encapsulation material (claim 11) / use rigid epoxy as the encapsulation material (claims 12-13) since (1) Japan 325, directed to the

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tire art, teaches coating the transponder for transmitting information with epoxy resin and (2) Europe 196, also directed to the tire art, suggests encapsulating components of a device for transmitting information with rigid epoxy resin to provide protection for the components of the device (col. 5 lines 30-37).

**7) Claims 10-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 325 in view of Lee et al (US 5731754) and/or Europe 861 (EP 694861).**

As to claims 10-11 and 14, it would have been obvious to one of ordinary skill in the art to encapsulate Japan 325's transponder for a tire with encapsulation material (claim 10) / entirely surround the transponder with encapsulation material (claim 11) / use flexible encapsulation material (claim 14) in view of (1) Lee et al's suggestion to dispose a transponder for a tire in encapsulating medium 7 such as rubber (a flexible material) for compatibility with a vehicle tire (col. 2 lines 45-65) and/or (2) Europe 861's to house a transponder for a tire in a high elastic housing such as rubber or high elastic plastic to protect the transponder from the outside particularly against mechanical effect (see machine translation).

#### Remarks

8) Claim 17 should be identified as "cancelled" since there is no claim 17.

The remaining references are of interest.

9) No claim is allowed.

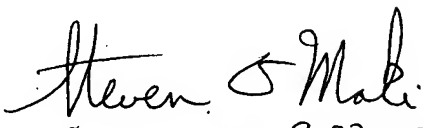
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10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki  
September 23, 2005

  
STEVEN D. MAKI 9-23-05  
PRIMARY EXAMINER  
~~GROUP 1300~~  
AU 1733